

(B) Remarks

The allowance of claims 18 and 22 is gratefully acknowledged. A review of these claims revealed they are identical and therefore claim 22 is canceled without prejudice. Also, these claims originally recited “--- said first triangularly shaped building element having *two* boundaries partly contiguous with *each of* said second and third triangularly shaped building elements --“ emphasis added. There are only two boulder walls that are contiguous, one with the second building element and the other with the third building element. Claim 19 is amended to properly recite these boundaries and comply with 35 U.S.C. §112.

The indication that claim 3, 4 and 11 - 15 would be allowable if rewritten to overcome the §112 rejection and include the limitations of the base claim and any interleaving dependent claim is also gratefully acknowledged. Accordingly, original claim 3 is presented as new claim 23; original claim 4 is presented as new claim 24; and original claim 11 is presented as new claim 25. It is to be noted that original claim 11 should properly depend on claim 10, not claim 8. Claim 25 includes the limitation of dependent claim 10. New depended claims 26 - 29 correspond to claims 12 -15.

New claims 30 - 32 are based on the applicant's original disclosure including Figure 6 and the description on page 9, lines 4 - 20. Independent claims 1, 17, 19, and 21 are amended to better distinguish over the cited prior art. Original dependent claims 3, 4, and 11 - 15 are retained in the application, now depending on amended claim 1. Claim 5 is amended to correct an error; claim 11 is amended to correct the error noted supra; and claim 16 is amended to overcome the rejection under 35 U.S.C. §112.

Independent claims 1, 17, and 21 stand rejected as anticipated by the disclosure of the Nelson '998 reference. The disclosure by this reference is believed improperly construed

based on an improper hindsight use of the applicant's disclosure and claims. In Glaverbel Societe Anonyme v. Northlake Marketing & Supply Inc. 33 USPQ2d 1496 (Fed. Cir. 1995) at 1498, the principle of anticipation was explained by the Court.

"In determining whether a patented invention is anticipated, the claims are read in the context of the patent specification in which they arise and in which the invention is described. If needed to impart clarity or avoid ambiguity, the prosecution history and the prior art may also be consulted in order to ascertain whether the patentee's invention is novel or was previously known to the art." *Lindemann*, 730 F.2d at 1458, 221 USPQ at 485 ("In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in light of the specification and prosecution history and identify corresponding elements disclosed in the allegedly anticipating reference.") Cf. *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed.Cir.1987) (Claims are not interpreted "in a Vacuum").

The examiner has not carried the burden of establishing anticipation. The claimed recitations have not been read in light of Appellant's specification and the rejection should be withdrawn.

In the rejection of claims 1, 5 -10, 16, 17, 20 and 21 under 35 USC §102 (b) the language of the applicant's claim 1 was used to alter the Nelson reference to support the contention that:

"Nelson teaches a building including the combination of *an array of first* (10 in Figure 8), *second* (10A in Figure 8), and *third* (10 in Figure 8) triangular *façade* elements with the *second façade jutting from side boundaries of each of the first and third triangular facades*. ---" (Emphasis added)

The rejection is wrong because the inserted reference numerals from the Nelson reference rewrite the specification of the Nelson reference using applicants claim terminology and the improper hindsight use of Appellant's invention. Reference numerals 10 and 10A in Nelson are the basic right triangular components shown in Figure 1 for a single building unit that is used in the construction of structures disclosed in Figures 3, 5, 7 - 10, 12, 14, 17, and 20. (Nelson, Column 3, lines 14 – 19 and lines 30 - 48) The identification of Figure 8 as the basis

for the *teachings* fails to do so. In Nelson, Figure 8 is identified at column 2, lines 46-48 as:

“FIG. 8 is a perspective showing how the size of the gabled structure in FIG. 3 may be modified by adding additional components;”

and the only remaining identification of the drawing Figure 8 occurs in Column 4, lines 63 – 65 as:

“Additional components 10 and 10A may be added to the structure without affecting its function as shown in FIGS. 7 and 8.”

The Nelson specification was rewritten as to the Applicant’s recitation in claim 1 of “A building including the combination of an array of first, second and third triangular facades ---”. The concept of an array of the combination of three facades is taught only by the Applicant. The array is additionally defined by the relationship between the facades namely: “ with said second triangular facade jutting from side boundaries of each of said first and third triangular facades.” Nelson’s teaching of merely increasing the number of components 10 and 10A cannot be properly construed as a showing or even an accidental teaching of a three component array of facades with one jutting from side boundaries of the others. Figure 8 shows an underlying addition to the arrangement of Figure 3 of three inverted pairs of components 10A at each of four sides joined at corner points by a pair of components 10. Figure 3 shows a pair of components 10A at each of four sides joined at corner points by a pair of components 10. Merely identifying components 10 and 10A and Figure 8 does not carry the burden of establishing anticipation of the recitation noted in Applicant’s claim 1. As the Court pointed out *supra*, the meaning of the elements of the claim must be determine in light of the specification. The Applicant describes:

“Accordingly, it is an object of the present invention to provide a static building structure embodying at least three triangularly shaped facades interrelated according to a particular arrangement orientanable in three-dimensional space to form any one of a multitude of architectural configurations suitable for structures to be erected on either level land or undulating

terrain.”(Page 2, lines 2 – 6)

Not with standing the reasons for the belief the rejection based on an anticipation should be withdrawn, claim 1 now includes the recitation of:

“--said second triangular facade *having an angler projecting boundary jutting from an elongated central axis at the junction of side boundaries of each of said first and third triangular facades.*”(Emphasis added)

The angler projecting boundary related to the relationship of the axis serves to further set applicant’s invention apart from the Nelson reference. Accordingly claim 1 and dependent claims 2 – 16 are submitted to be patentably distinguished over the Nelson prior art. Independent claims 17 and 21 now recite the same recitation as added to claim 1 and for the same reason these claims are now believed patentable.

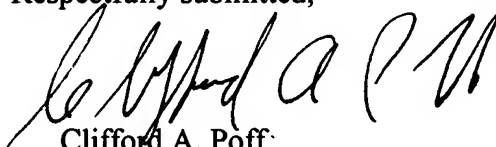
Claims 1, 2 and 19 were rejected as anticipated by the Johnson ‘626 reference. The rejection contends the Johnson reference “teaches a building with a combination of first 49, second 48 and third 47 triangular façade elements, with the second element jutting from side boundaries of each of the first and third facades.” Johnson describes 47, 48, and 49 are truncated tetrahedral sections stacked one above the other to form a multi story structure.(Johnson, Column 3, lines 21 – 25) It is also respectfully submitted the Johnson teaching was improperly rewritten with the hindsight use of applicant’s claim language and specification. Claim 17 is amended in the same manner as claim 1 as discussed above and it is submitted claims 1, 2, and 19 are now believed patentable over the Johnson reference. It is noted dependent claim 20 was rejected as anticipated by Nelson and parent claim 19 was rejected as anticipated by Johnson. It is submitted that a finding that the allowance of claim 19 will include and allowance of claim 20.

Accordingly, it is believed that this application is in condition for allowance and

such action is earnestly solicited. In the event the Examiner believes a telephone interview will further the prosecution he is invited to telephone the undersigned at 412-366-6200.

Attached hereto is check no. 13385 in the amount of \$169.00 for payment of two additional independent claims and nine additional dependent claims in excess of twenty.

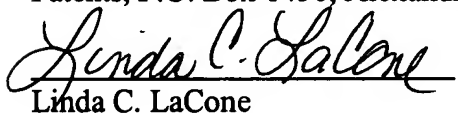
Respectfully submitted,



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Enclosure

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 15, 2004


Linda C. LaCone

Date: November 15, 2004